Remarks/Arguments

A.   Claims in the Case

Claims 81-95 are pending. Claims 81, 86, and 91-95 have been amended.

B.   Claim Objections

The Examiner objected to claim 81 based on informalities. Applicant has amended claim 81 for clarification to recite in part: "configuring one or more processing parameter values for use in processing transaction-related data in the FSO computer system."

C.   35 U.S.C. §112, Second Paragraph

The Examiner rejected claims 81, 86, 91 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner takes the position that claims 81, 86, and 91 contain one or more "clauses of intended use which renders the claim indefinite." The Examiner states:

> Specifically, claim 81 in the first claim limitation reciting "parameter from a first program, wherein the key definition ... ; selecting a search mask ... wherein the selected search mask table ...; reading a first search mask ..., wherein the first search mask ...;" Also on page 19, lines 7 and 15 contain "wherein" clauses.
> ...
> Claims 86 and 91 have a similar problem with the "wherein" clause

The Examiner appears to broadly consider all "wherein" clauses in Applicant's independent claims as suspect. The Examiner relies on MPEP § 2111.04, which states:

> examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are:

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(A) "adapted to" or "adapted for" clauses;
(B) "wherein" clauses
(C) "whereby clauses.

Despite the above-quoted language from MPEP § 2111.04, <u>none</u> of the cases cited in MPEP § 2111.04 appear to describe a "wherein" clause found to have a limiting effect. Applicant notes, moreover, that "wherein" clauses are commonly used to introduce additional features into claims (in dependent claims, for example).

In any event, Applicant disagrees that the particular clauses in Applicant's claims 81, 86, 91 recite only an intended use, what is expected to happen, or a desired result. For example, "the key definition comprising the identity of one or more data element values in a set of transaction-related data" is not an intended use, what is expected to happen, or a desired result, but defines a specific feature of the key definition. Likewise, "the selected search mask table comprising one or more search masks" and "the first search mask comprising one or more search mask fields" do not merely recite an intended uses, what is expected to happen, or desired results.

MPEP § 2111.04 cites a single case in which a clause – in particular, a "whereby" clause – was held to be not of limiting effect. The claim at issue in that case stated in part:

> 1. A method for trading securities between individuals, comprising:
> * * *
> executing a trade of the security based on information contained in the offer for consideration specified in the reply to the offer, *whereby the security is traded efficiently between the first [offering] individual and the second [replying] individual;*
> * * *.
>
> *Minton v. National Ass'n. of Securities Dealers, Inc.* , 336 F.3d 1373, 1380 (Fed. Cir. 2003)

The *Minton* court stated:

> The district court was also correct in not giving weight to the "traded efficiently"
> phrase in the whereby clause of the executing step. A whereby clause in a method
> claim is not given weight when it simply expresses the intended result of a process
> step positively recited. *Tex. Instruments Inc. v. U.S. Int'l Trade Comm'n,* 988 F.2d
> 1165, 1172 (Fed.Cir.1993). That is the case here. The term "efficiently" on its face
> does not inform the mechanics of how the trade is executed, and nothing in the
> specification or the prosecution history suggests otherwise. Rather, the term
> "efficiently" is a laudatory one characterizing the result of the executing step. We
> therefore hold that the district court correctly declined to give the term the meaning
> Minton has proposed.

> *Minton v. National Ass'n. of Securities Dealers, Inc.,* 336 F.3d 1373, 1381 (Fed. Cir.
> 2003)

Unlike the "traded efficiently" phrase in *Minton* case, the features in Applicant's claims introduced by the word "wherein" are not simply expressing an intended result of a process, but recite additional features of a claimed process.

Applicant notes that MPEP § 2111.04 appears to pertain to determination of claim scope, and not indefiniteness under 35 U.S.C. § 112, second paragraph. In particular, MPEP § 2111.04 addresses whether a particular clause in a claim is given "limiting effect". See MPEP § 2111.04 ("Claim scope is not limited by..." and "examples of claim language...that may raise a question as to the limiting effect of language in a claim are...") (See also parent section § 2111, "Claim Interpretation; Broadest Reasonable Interpretation"). Likewise, the holding in the two cases cited in MPEP § 2111.04 (as they relate to a "whereby" clause) are concerned with whether particular claim language is given limiting effect, not whether the claims were indefinite under 35 U.S.C. § 112, second paragraph. Applicant submits that even if a claim did include a statement of intended use (Applicant submits that claims 81, 86, 91 do not), the claims is not for that reason rendered indefinite under Section 112, second paragraph.

For the foregoing reasons, Applicant respectfully disagrees with the Examiner's rejections under U.S.C. 112, second paragraph, as they relate to the "wherein" clauses in Applicant's claims. Nevertheless, to expedite prosecution of the case, Applicant has amended claims 81, 86, 91 for clarification.

The Examiner rejected claim under 35 U.S.C. §112, second paragraph, as being incomplete for omitting "essential steps, such omission amounting to a gap between claim limitations". The Examiner states: "it is unclear what happens if X occurs or X does not occur does Y occur or does Y not occur."

Applicant's claims are generally directed to a method of obtaining data used to process financial transactions. A processing program may send a request for processing parameters to process the transaction. The processing parameters may be accessed from a processing parameters table, which is selected based on the type of transaction received. (See, e.g., Specification, pg. 22, lines 23-28). To access the processing parameter that the received transaction needs, a key is created which is specific for the received transaction. The key will point to a particular location in the processing parameters table. A search mask table includes one or more search masks to be used by a key building program to create a key. By referencing the search mask and collecting the indicated data from data elements of the received transaction, the key building program may prepare a first key. After the first key has been created, a search of the processing parameters table is made to determine if the created key matches a key entry in the processing parameters table. If a match is found, the processing parameters associated with the key are collected and transferred to the transaction processing program. If the first created key does not match any of the key entries in the processing parameters table, one or more additional keys may be created using different search masks. To build a new key, the key building program may access the next search mask and a new key may be created based on the next search mask.

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The newly created key may be used to search the processing parameters table for a matching entry. This process may be repeated until a matching entry is found, or until there are no additional search masks to be used to create a new key. For example, Applicant's specification states:

> PCD program 512 may notify key building program 506 that no match was found for processing key value 528 in PCD table C 526. Referring to Figure 3b, key building program 506 may include program instructions 514 for building a key value. Program instructions 514 may use key definition 510 and a second search mask 530 read from search mask table 522 to build a second key value 532 from data element values read from database 518 and transaction 502.
> After processing key value 532 is built by program instructions 514, processing key value 532 may be passed to PCD program 512.
> (Specification, pg. 26, lines 8-14)

> Key building program 506 and PCD program 512 may continue to search PCD table C 526 for a match to a processing key value constructed from transaction and database data element values and wildcard values until a match is found or until all the search masks in search mask table 522 have been used without finding a matching PCD key value.
> (Specification, pg. 27, lines 13-17)

In the embodiments described with respect to FIGS. 3a and 3b, search masks are provided in a search mask table. Each search includes a field for each key element if a key definition associated with the search mask table. Program instructions use the search mask to build a first key value from data element values. If the first key value matches a key value in the PCD table, the PCD value corresponding to the matching key value may be sent to the transaction processing program. If, however, the PCD table does not include a key value that matches the key value built using the search mask (as in Figure 3a, where [1,8] is not found in the PCD table), then another search mask in the table is used to build a second key value. Once a matching key value is found (as in FIG. 3b, where [1,*] is found in the PCD table), the PCD value corresponding to the matching key value may be sent to the transaction processing program.

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Claim 81 has been amended to recite:

> if a match is found between the first processing key value and one of the one or more
> key values stored in the database, reading from the database a processing
> parameter value associated with the matching key value;
> if a match is not found between the first processing key value and one of the one or
> more key values stored in the database:
>> creating one or more additional processing key values, the one or more
>> additional processing key values being formed using one or more
>> additional search masks obtained from the selected search mask table;
>> comparing the one or more additional processing key values to one or more
>> key values in the database until a match is found between at least one
>> of the one or more additional processing key values; and
>> reading from the database a processing parameter value associated with the
>> matching key value;

Applicant submits that amended claim 81 recites what is to occur if a match _is_ found

between the first processing key value and one of the one or more key values stored in the

database, and also recites what is to occur if a match _is not_ found between the first processing

key value and one of the one or more key values stored in the database. Applicant submits that

amended claim 81 is not incomplete for omitting essential steps.

The Examiner states:

> The omitted steps are: Claim 81, the step of "if the search mask field value does not
> comprise a wildcard search mask field value not comparing the first processing key
> value to one or more key values in the database."

Applicant respectfully submits that the step proposed by the Examiner in the quotation above is

not an essential step of the method of claims 81, 86, or 91. In the example set forth above with

respect to FIG. 3a, for example, the first processing key value is compared to one or more key

values in the database even though the search mask field does not comprise a wildcard search
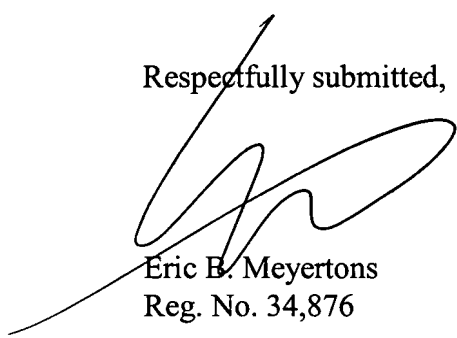
mask field.

For the foregoing reasons, Applicant respectfully requests removal of the rejections under 35 U.S.C. 112, second paragraph.

D.   Additional Remarks

Based on the above, Applicant submits that the claims are now in condition for allowance. Favorable reconsideration is respectfully solicited.

Applicant has enclosed a Fee Authorization for a one-month extension of time. If any additional extension of time is required, Applicant hereby requests the appropriate extension of time. If any fees are inadvertently omitted or if any additional fees are required or have been overpaid, please appropriately charge or credit those fees to Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C. Deposit Account Number 50-1505/5053-31301/EBM.

Respectfully submitted,

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